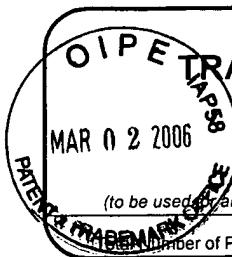03-06-06

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- [ ] Fee Transmittal Form
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- [ ] Amendment/Reply
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- [ ] After Allowance Communication to TC
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- [x] Appeal Communication to TC (Amended Appeal Brief (29 pages)
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  1. Return Postcard
  2. Response to Notice of Non-Compliant Appeal Brief (37 CFR 41.73)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Townsend and Townsend and Crew LLP
Signature	
Printed name	William J. Daley
Date	March 2, 2006
Reg. No.	52,471

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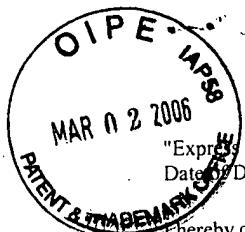
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60715228 v1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jeffry J. Grainger Application No.: 09/996,338 Filed: November 27, 2001 For: METHOD OF CREATING ELECTRONIC PROSECUTION EXPERIENCE FOR PATENT APPLICANT Customer No.: 20350	Confirmation No. 1985 Examiner: Mooneyham, Janice Technology Center/Art Unit: 3629 RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF (37 CFR 41.37)

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Alexandria, VA 22313-1450

Sir:

    In response to the Notice of Non-Compliant Appeal Brief (37 CFR 41.37) mailed February 7, 2006, please enter the attached AMENDED APPEAL BRIEF UNDER 37 CFR §41.37. Appellant has added Section 10 - "Related Proceedings Appendix" and Section 11- "Evidence Appendix" as requested in the Notification.

                                      Respectfully submitted,

                                        William J. Daley
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PATENT

Attorney Docket No.: 21737-000730

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	Confirmation No.: 1985
Jeffry J. Grainger	Examiner: Mooneyham, Janice
Application No.: 09/996,338	Art Unit: 3629
Filed: November 27, 2001	~~APPEAL BRIEF UNDER 37 CFR §41.37~~
For: METHOD OF CREATING ELECTRONIC PROSECUTION EXPERIENCE FOR PATENT APPLICANT	AMENDED APPEAL BRIEF UNDER 37 CFR §41.37
Customer No.: 20350	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant offers this Amended Appeal Brief in response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed February 7, 2006 by the U. S. Patent Office. Appellant has added Section 10 - "Related Proceedings Appendix" and Section 11- "Evidence Appendix" as requested in the Notification.

Appellant offers this B further to the Notice of Appeal mailed on May 13, 2005. The original deadline for this Brief fell on July 13, 2005. A petition for a four-

month extension of time is enclosed, extending the deadline through November 13, 2005, which fell on a weekend. Accordingly, this Brief, which is filed on the first business day after November 13, 2005, is timely filed.

1. Real Parties in Interest

The real party in interest is FTF, Inc., the assignee of this Application.

2. Related Appeals and Interferences

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. Status of Claims

Claims 4-9, 11-13, 19-34 are currently pending in the application. Claims 1-3, 10 and 14-18 have been canceled. Claims 4-9, 11-13, and 19-34 stand rejected pursuant to a Final Office Action mailed January 14, 2005 (hereinafter "the Final Office Action"). The rejections of claims 4-9, 11-13 and 19-34 are believed to be improper and are the subject of this appeal.

A copy of the claims as rejected is attached as an Appendix.

4. Status of Amendments

No claims have been amended since the mailing of the Final Office Action.

5. Summary of Claimed Subject Matter

In the following summary, Appellant has provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be merely illustrative in nature.

The claimed subject matter is directed generally to methods and systems for managing intellectual property. There are three independent claims at issue in this appeal: claim 19, claim 20 and claim 27.

In the embodiment of independent claim 19, a method of managing electronic documents related to a plurality of patent applications comprises, for a plurality of different and unrelated technology developers (Application, p. 8, ll. 23-26, p. 9, ll. 16-19), allowing users from each such technology developer to create a plurality of invention disclosures for each respective technology developer (Application, p. 4, ll. 29-30, p. 24, ll. 18-34, p. 25, ll. 14-18). The method also comprises receiving the plurality of invention disclosures from the users from each technology developer at a server system over a network and storing each invention disclosure in one of a plurality of collections of electronic documents and data in a computer readable memory operatively coupled to the server system. (Application, p. 24, ll. 18-34, p. 4, ll. 32-33, p. 15, ll. 6-11). Each collection is associated with one of the plurality of patent applications and assigned to at least one group that can be used in determining whether a user may access electronic documents and data in the particular collection (Application, p. 15, ll. 6-27, p. 16, ll. 26-27).

Additional electronic documents are stored in the database. (Application, p. 15, l. 28 – p . 16, l. 9). These additional electronic documents are associated with at least some of a plurality of invention disclosures for each technology developer. (Application, p. 15, ll. 6-27, p. 16, ll. 26-27).

The method of claim 19 further comprises maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents,

such that at least some users associated with each technology developer in the plurality of technology developers can access selected ones of the electronic documents associated with invention disclosures created for the respective technology developer, and such that users associated with a particular technology developer cannot access electronic documents in the database associated with invention disclosures of other unrelated technology developers in the plurality of technology developers. (Application, p. 5, ll. 6-30).

The method of claim 19 also comprises maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents for users associated with a plurality of patent firms. (Application, p. 5, ll. 23-27) Hence, at least some users from selected patent firms have rights to view selected invention disclosures stored in the collections and selected electronic documents stored in those collections, and to create and modify patent applications prepared for the selected invention disclosures. (Application, p. 5, ll. 23-27, p. 17, ll. 8-20). Any such created patent application is received at the server system and stored in the collection of electronic documents in which the respective invention disclosure is stored. (Application, p. 15, l. 28 – p. 16, l. 8).

The method of claim 19 further comprises maintaining and enforcing rights to file patent applications in a patent office for users associated with the plurality of law firms, such that only selected users from the law firms have rights to file patent applications in the patent office (Application, p. 5, l. 30 – p. 6, l. 3). Hence, the method includes electronically receiving a request from a user to file a particular patent application for a first technology developer in the plurality of technology developers, determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request. (Application, p. 5, l. 30 – p. 6, l. 3).

Each user from the plurality of different and unrelated technology developers and each user from the plurality of patent law firms is assigned to at least one group that can be used in determining whether a user may access electronic documents

and data in a particular collection of electronic documents (p. 16, ll. 26-32). In addition, each user is assigned one or more roles that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection (p. 14, ll. 5-6, p.16, l. 33 – p. 17, l. 34).

When a user generates a request to perform an operation on an electronic document in a particular collection of electronic documents, in response to receiving the request, the method of claim 19 includes determining (i) a first group to which the user is assigned (Application, Fig. 8, # 935, ¶ 54H);[1] (ii) a second group to which the electronic document is assigned (Application, Fig. 8, # 930, ¶ 54H); (iii) one or more roles to which the user is assigned (Application, Fig. 8, # 925, ¶ 54H); (iv) unit level access information for the particular collection of electronic documents (Application, Fig. 8, # 910, ¶ 54G); and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned, the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents. (Application, Fig. 8, # 915, 940, 955, ¶¶ 54G-H).

Claim 20 is directed to a server system for managing intellectual property. The system (Fig. 2, # 100) comprises a processor and a computer-readable memory coupled to the processor. The computer-readable memory is used to store a plurality of collections of electronic documents and data related to a plurality of invention disclosures for a plurality of different and unrelated technology developers, wherein the plurality of electronic documents include invention disclosures, patent applications and additional documents associated with the invention disclosures and/or patent applications. (Application, p. 10, l. 29 – p. 11, l. 5, p. 15, l. 6 – p. 16, l. 8).

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[1] An Amendment dated July 13, 2004 added Figures 6-9 and paragraphs 23A-D, 49A-C, 50A-F and 54A-K, to the Application, as well as amending other portions of the written description. The added material was copied from U.S. Provisional Application No. 60/333,962, entitled "Data Access Control Techniques Using Roles and Permissions" (attorney docket no. 020313-001710), which was originally incorporated by reference in the Application at page 18, lines 4-10.

The system of claim 20 further includes an invention disclosure creation component that allows users from each of the plurality of technology developers to create invention disclosures for the respective technology developer each client system is associated with and store the invention disclosures in the database as electronic documents (Application, p. 4, ll. 29-30, p. 24, ll. 18-34, p. 25, ll. 14-18), and a patent application creation component that allows users associated with a plurality of patent firms to create and modify patent applications prepared for selected invention disclosures stored in the database and store the patent applications in the database as electronic documents. (Application, p. 7, ll. 30-33, p. 25, ll. 8-19, p. 34, ll. 5-12).

The system of claim 20 also includes a document management and access component that maintains and enforces rights to electronic documents in the database. Accordingly, in response to receiving a request from a user to perform an operation on an electronic document in a particular collection of electronic documents, the system determines (i) a first group to which the user is assigned (Application, Fig. 8, # 935, ¶ 54H); (ii) a second group to which the electronic document is assigned (Application, Fig. 8, # 930, ¶ 54H); (iii) one or more roles to which the user is assigned (Application, Fig. 8, # 925, ¶ 54H); (iv) unit level access information for the particular collection of electronic documents (Application, Fig. 8, # 910, ¶ 54G); and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned, the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents. (Application, Fig. 8, # 915, 940, 955, ¶¶ 54G-H).

The system of claim 20 further comprises a patent application filing component that, in response to receiving a request from a user to perform an operation of filing a particular patent application, causes the patent application to be filed in the patent office if the document management and access component determines the user has sufficient rights to perform the filing operation. (Application, p. 5, l. 30 – p. 6, l. 3, p. 34, l. 13 – p. 35; l. 8).

The embodiment of claim 27 is directed to a method of managing electronic documents related to a plurality of patent applications. The method comprises storing a plurality of collections of electronic documents and data on a computer-readable memory operatively coupled to a server system. (Application, p. 10, l. 29 – p. 11, l. 5, p. 15, l. 6 – p. 16, l. 8). Each collection is associated with one of the plurality of patent applications. (Application, p. 15, ll. 10-11). In addition, each collection includes data and one or more electronic documents related to its respective patent application. (Application, p. 10, l. 29 – p. 11, l. 5, p. 15, l. 6 – p. 16, l. 8). Each collection is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in the particular collection. (Application, p. 16, ll. 26-32). The plurality of collections of electronic documents includes at least a first collection associated with a first patent application.

The method of claim 27 further comprises allowing a plurality of users to perform operations on electronic documents in the plurality of collections of electronic documents and data. Each user is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in a particular collection of electronic documents (Application, p. 16, ll. 26-32), and each user is assigned one or more roles that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection. (Application, p. 16, l. 33 – p. 17, l. 20).

A request to perform an operation on an electronic document in the first collection is received from a first user. The method of claim 27 also includes, responsive to receiving the request, determining a first group to which the first user is assigned (Application, Fig. 8, # 935, ¶ 54H); determining a second group to which the first collection is assigned (Application, Fig. 8, # 930, ¶ 54H); determining one or more roles to which the first user is assigned (Application, Fig. 8, # 925, ¶ 54H); and determining if the user can perform the operation on the electronic document in the first collection, based upon the first group to which the user is assigned, the second group to which the

first collection is assigned and the set of permissions associated with the one or more roles to which the user is assigned. (Application, Fig. 8, # 940, 955, ¶¶ 54G-H).

6. Grounds of Rejection Presented for Review

Claims 4-9, 11-13 and 19-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,424,580 (hereinafter "Takano") in view of U.S. Patent 6,584,466 (hereinafter, "Serbinis"). Paragraphs 3 (et seq.) and 4 (et seq.) of the Final Office action summarize the Examiner's position on this issue.

7. Argument

The Final Office Action rejected claims 4-9, 11-13 and 19-34 as unpatentable under 35 U.S.C. § 103(a). Section 2143 of the MPEP establishes three criteria to support such a rejection: "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." The Final Office Action meets none of these criteria.

As described in detail below, Takano and Serbinis each fail (either individually or collectively) to teach or suggest each element of any pending claim. Further, the Final Office Action does not make the requisite showing of a teaching or suggestion to combine Takano and Serbinis in the contemplated manner. Finally, there would be no reasonable expectation of success in the proposed combination of Takano and Serbinis. Accordingly, the rejections of claims 4-9, 11-13 and 19-34 should be reversed.

A.   The cited references fail to teach each element of any claim at issue on appeal.

As noted in the Amendment dated July 13, 2004, Takano is directed to a system for preparing patent applications for a single entity or company. The system in

Takano allows for inventors of the single company to create invention disclosures and forward the disclosures to an appropriate patent attorney for preparation of a patent application. *See, e.g.*, Takano, c. 5, l. 52 to c. 6, l. 15. The inventor and attorney interact with a common server computer over a network connection such as the Internet. *Id.*, c. 5, ll. 49-51. Specifically, Takano provides for a system with a server and dedicated client applications, which provide the functionality described in Takano. *See id.*, c. 6, ll. 44-59 (describing the functionality of a draft preparation program on a client computer), c. 8, ll. 7-42 (describing the functionality of a draft revision program on another client computer).

There is no disclosure or suggestion that Takano's system can be used to create invention disclosures and patent applications and track other related electronic documents associated with the same for multiple, unrelated companies or technology developers. Consequently, Takano provides no disclosure of any access controls for protecting invention disclosures, patent applications, or other documents from access by unauthorized persons, since Takano does not envision a situation in which multiple independent entities might have access to Takano's system. Nor, as acknowledged by the Examiner, is there disclosure in Takano, of maintaining and enforcing access rights among multiple law firms to patent application data stored in a common repository.

In contrast, Serbinis has nothing to do with the preparation of patent applications. Serbinis is directed to a web-based system for allowing document storage, collaborative file sharing and workflow, document delivery and document distribution. See Serbinis, c. 2, ll. 16-21. Notably, Serbinis (which does provide a number of access-control and security facilities), depends on a web-browser based system of collaboration, which eschews "the need for a specialized client application" in favor of "a previously known web browser." Id, c. 2, ll. 13-15.

As explained below, event if taken together, Takano and Serbinis fail to teach or suggest the elements of the pending claims, which are directed generally to methods and systems for managing intellectual property for a plurality of unrelated entities, such that access to patent application-related documents needs to be managed.

i.   *Takano and Serbinis each fail to teach or suggest user roles.*

Independent claims 19, 20 and 27 each recite, with respect to a requested or operation on an electronic document, "determining . . . one or more roles to which the user is assigned" and based, inter alia, on "the set of permissions associated with the one or more roles" determining "if the user can perform the operation on the electronic document." Neither Takano nor Serbinis teach the use permissions in user roles to determine whether a user can perform an operation on an electronic document.

The Final Office action concedes Takano's failure to teach or suggest these elements of the claims. Final Office Action at 9. The Final Office Action asserts, however, that Serbinis does teach "each user is assigned one or more roles that are associated with a set of permissions." Final Office Action at 5, (citing Serbinis, c. 2, ll. 41-43); Final Office Action at 10 (citing Serbinis, c. 6, ll. 35-46, c. 9, ll. 19-32 and c. 11, ll. 21-35). The Final Office Action also asserts that Serbinis teaches "determining if the user can perform the operation on the electronic document in the first collection (document) based upon . . . the set of permissions associated with the one or more roles to which the user is assigned." Final Office Action at 10 (citing Serbinis, c. 9, ll. 19-33).

None of the cited passages (nor any other portion of Serbinis) teaches or suggests the use of permissions associated with user roles, as recited by claim 19, 20 and 27. While Serbinis does teach the use of a variety of access control mechanisms, including user-level and group-level access controls, *see*, e.g., Serbinis, c. 6, ll. 41-45 (teaching "user group information, i.e., information on the group of users that the user is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group), <u>Serbinis does not teach any user roles other than group membership, and in particular does not teach that any specific permissions might be associated with such roles.</u>

The portions of Serbinis cited by the Final Office Action, when considered carefully, belie the assertion that Serbinis teaches user roles and associated permissions. For example, one cited portion (c. 2, ll. 41-43) describes "specific access-control protocols, for example, so that specific users; privileges with respect to a document may

be defined." Taken alone, however, the term "access-control protocols" does not even come close to teaching or suggesting user roles with associated permissions, and Serbinis fails to provide any explication of what such protocols might involve.

Another portion of Serbinis (c. 6, ll. 35-46) cited by the Final Office Action is quoted above and discusses only how a user's membership in a particular group might be used for access control purposes. As recited by claims 19, 20 and 27, however, the concept of a user role having associated permissions is distinct from the concept of group permissions. This can be seen easily from the text of claims 19, 20 and 27 themselves, which recite, as a basis of determining if the user can perform an operation, both the "group to which the user is assigned" and "the set of permissions associated with the one or more roles to which the user is assigned." Hence, the group-level permissions taught by Serbinis fail to teach or suggest the user roles recited in claims 19, 20 and 27.

The remaining passages of Serbinis cited by the Final Office Action similarly fail to teach or suggest user roles with associated permissions. Instead, those passages deal with permissions assigned to specific users, not to user roles. For example, at column 11, lines 21-22, Serbinis teaches that "the Originator may designate the Authorized Users for the document, and the access rights to be granted to those Authorized Users." The Final Office Action apparently reads the term "Authorized User" as connoting a role with an associated set of permissions.

However, Serbinis thereafter describes how specific authorized users are granted user-level permissions, which have nothing to do with the alleged role of "Authorized User": "For example, an Authorized User only may be allowed to view a document, but not be allowed to edit the document. Additionally, an Authorized User may be granted access to the document only for a limited period of time." Serbinis, c. 11, ll. 29-34. Later, Serbinis describes how "the existing pre-registered Authorized User is simply given authorization to access the new document." Serbinis, c. 12, ll. 18-19. Clearly, Serbinis contemplates allowing access to authorized users based not on any particular permissions associated with a role of "Authorized User," but on individual (user-level) permissions assigned to each of those users. In particular, the Final Office

Action identifies nothing in Serbinis that might lead one skilled in the art to conclude that the term "Authorized User" (or any other teaching of Serbinis, for that matter) suggests the use of user roles and associated permissions, as recited by claim 19, 20, and 27, rather than merely user-level permissions.

Hence, taken either alone or in combination, neither Takano nor Serbinis teaches nor suggests "determining . . . one or more roles to which the user is assigned" and based, inter alia, on "the set of permissions associated with the one or more roles" determining "if the user can perform the operation on the electronic document," as recited by claims 19, 20 and 27. For at least this reason, the rejections of claims 19, 20 and 27, and dependent claims 4-9, 11-15, 21-26 and 28-34 (each of which depend, either directly or indirectly from one of claims 19, 20 or 27) should be reversed.

ii Takano and Serbinis fail to teach or suggest the recited combination of permissions.

Claims 19 and 20 each recite, inter alia, maintaining and enforcing rights to electronic documents, including in particular "determining (i) a first group to which the user is assigned; (ii) a second group to which the electronic document assigned; (iii) one or more roles to which the user is assigned. (iv) unit level access information for the particular collection of electronic documents and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned, the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents.

Somewhat similarly, claim 27 recites "determining a first group to which the first user is assigned; determining a second group to which the first collection is assigned; determining one or more roles to which the first user is assigned and determining if the user can perform the operation on the electronic document in the first collection based upon the first group to which the user is assigned, the second group to which the first collection is assigned and the set of permissions associated with the one or more roles to which the user is assigned."

Neither Takano nor Serbinis teaches or suggests this particular procedure for maintaining and enforcing rights to access electronic documents and data. Even assuming Serbinis teaches user roles and associated permissions (which, as noted above, it does not), neither Serbinis nor Takano teaches the use of a particular combination of (i) a user group, (ii) a document group, and (iii) permissions associated with user roles to determine whether a user can perform an operation on an electronic document, as recited by claim 27. A fortiori, Serbinis and Takano each fail (either individually or collectively) to teach or suggest using this combination, along with (iv) unit-level access information, to make such a determination, as recited by claims 19 and 20.

For example, there is no disclosure in Takano et al of combining three different data (user group information, document group information and user role information) in making a determination as to whether or not a particular user can perform a particular operation. Furthermore, the appellants respectfully assert the secondary reference, Serbinis et al., does not make up for this deficiency in the primary reference. For example, there is no disclosure in Serbinis et al. of using both user group information and user role information in making a determination as to whether or not a particular user can perform a particular operation.

Accordingly, the appellants respectfully submit that claims 19, 20 and 27, as well as the remaining claims (each of which depend from one of these) are allowable over the combination of Takano and Serbinis for at least this additional reason. Accordingly, the rejections of those claims should be reversed for at least this additional reason.

iii. Takano and Serbinis fail to teach or suggest determining rights to file a patent application.

Independent claim 19 recites "electronically receiving a request from a user to file a particular patent application for a first technology developer in the plurality of technology developers, determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request." Independent claim 20 recites "a patent

application filing component that, in response to receiving a request from a user to perform an operation of filing a particular patent application, causes the patent application to be filed in the patent office if the document management and access component determines the user has sufficient rights to perform the filing operation." Neither Takano nor Serbinis teach these elements of claims 19 and 20.

The Final Office Action implicitly concedes that Serbinis fails to teach these elements of claims 19 and 20, but the Final Office action does assert that column 9, lines 1-8 and column 16, line 15 through column 18, line 18 teaches determining if the client system has appropriate rights to file the particular patent application, and, if so, causing the patent application to be filed in the patent office in response to the request. Final Office Action at 4. Neither of the cited portions, however, even mentions that Takano's system might determine if the client system has appropriate rights to file a patent application.

The first cited passage of Takano (c. 9, ll. 1-8) teaches merely that Takano's system "provides the benefit of enabling the client computer 100 used by an inventor preparing draft data for the specification for patent application and the client computer 200 used by patent-application-filing persons revising the draft data to prepare the specification for patent application very efficiently while transmitting and receiving the draft data via the server computer 300." This process of preparing draft data and revising a draft in no way can be read to teach or suggest even filing an application, let alone determining whether a client system has appropriate rights to file a patent application.

The other cited portion of Takano (c. 16, l. 15 – c. 18, l. 18), does describe how a patent application might be transmitted to a patent office. Neither that portion of Takano (nor any other), however, teaches or suggests "determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request," as recited by claim 19.

The Final Office Action also asserts that Fig. 18 of Takano teaches a patent application filing component. Final Office Action at 11. Fig. 18 of Takano is a schematic view of the overall system of Takano, and the appellants can see nothing in Fig. 18 that might be considered a "patent application filing component" (the Final Office Action does not identify which component of Fig. 18 the Examiner views as a patent application filing component). Even assuming some component of Fig 18 might be considered a patent application filing component, however, as noted above, nothing in Takano teaches or suggests that the patent application filing component might determine that a user has sufficient rights to perform a filing operation, and the Final Office Action fails even to address this element of claim 20. Consequently, Takano fails to teach or suggest this element of claim 20.

Hence, the combination of Takano and Serbinis fails to teach or suggest these additional elements of claims 19 and 20. For this additional reason, the rejections of claims 19 and 20 (and claims 4-9, 11-13 and 21-26, each of which depends directly or indirectly from claim 19) should be reversed.

iv. *Takano and Serbinis fail to teach or suggest presenting questions to a user.*

Dependent claim 8 recites, inter alia, that "the plurality of invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a Web page." Neither of the cited references teach or suggest this element, and claim 8 is allowable over the cited references for this additional reason.

The Final Office Action asserts that "Takano discloses a method in which there is a ready template data which make up a specification form for a patent application enabling the inventor to easily prepare a specification for the paten [*sic*] invention." Final Office Action at 6 (citing Takano, c. 9, ll. 46-51, Fig. 7). Even assuming this characterization of Takano is correct, it fails to teach or suggest the elements of claim 8.

For one thing, Takano relies on dedicated client software, not a web browser, to allow an inventor to provide invention data. Hence, Takano cannot be read to

either teach or suggest presenting questions to users via a web page. Moreover, Takano does not teach presenting questions for users to respond to. Instead, the cited portion of Takano teaches "the benefit of making ready template data, such make up a specification form for patent application, in the specification file 303 for the inventor using the client computer 100 and enabling the inventor to easily prepare a specification for patent invention." Takano, c. 9, ll. 46-51.

Providing a template for a specification form is in no way similar to presenting questions to be answered by an inventor. Merely by way of example, Figs. 3A-3L of the Application illustrate exemplary web pages presenting questions for a user to answer. This novel feature of certain embodiments provides many more benefits than merely presenting a template for a user. For instance, the questions can be phrased in an easy-to-understand manner, reducing the intimidation many inventors face when attempting to disclose an invention.

By contrast, the system of Takano merely "reads the template data, fetched by the template down loading means 105 into the text preparation software (step B4), and completes the draft data for the specification for patent application by having the inventor enter the text data in addition to the template data." Takano, c. 9, ll. 32-37. That is, Takano's template system simply provides some data for the user and then requires the user to enter additional information.

This disclosure neither teaches nor suggests the elements of claim 8. Accordingly, claim 8 is allowable over the cited combination for at least this additional reason, and the appellants respectfully request the reversal of the rejection of claim 8 for at least this additional reason.

For at least the reasons above, the combination of Takano and Serbinis fails to teach or suggest each limitation of any claim at issue on appeal, and for at least that reason, the cited combination fails to create a prima facie case of obviousness under § 103(a), and the rejections therefore should be reversed.

B.   *The Final Office Action establishes no motivation or suggestion to combine*
      Takano and Serbinis.

Even if the combination of Takano and Serbinis did teach or suggest each element of any pending claim (which, as noted above, it does not), the Final Office Action has established no motivation or suggestion to combine the references in the manner contemplated by the Final Office Action.

The Final Office Action asserts that "it would have been obvious to one or ordinary skill in the art at the time of the invention to incorporate into the disclosure of Takano the teachings of Serbinis so as to provide collaborative file sharing and workflow, document delivery and document distribution and to provide needed access-control protocols so that specific users' privileges with respect to a document may be defined." Final Office Action, at 5-6, 10, 13.

As noted above, however, Takano is directed to a closed system comprising a server and proprietary clients, for use by a single entity (corporation, etc.) to manage disclosures within that entity (in contrast to Serbinis, which is directed to an open, web-browser based system). As such, all necessary access controls are provided by the system itself—without the client application, a user would be unable to access the system at all. Moreover, because Takano, unlike the present claims, does not contemplate a system with multiple, independent entities, Takano would have no need to implement specific privileges for different entities. This can be seen by the fact that Takano nowhere even suggests that any sort of permissions or access controls might be implemented. Hence, incorporating the teachings of Serbinis would not provide any "needed access-control protocols," since Takano does not have any need for such controls.

Further, with respect to the other asserted benefits of Serbinis's teachings (collaborative file sharing and workflow, document delivery and document distribution), Takano already provides these features. Nothing in the Final Office identifies, and neither Takano nor Serbinis indicates, how the teachings of Serbinis might provide any additional benefit in these areas over what Takano already provides.

Additionally, even if there were some suggestion or motivation to combine Takano with Serbinis, that suggestion would be negated by the fact that Serbinis teaches away from the asserted combination. As noted above, the system of Takano depends on dedicated client software (and, more specifically, the functionality present in those applications, such as actuating text preparation software, actuating drawing preparation software, synthesizing text and drawings, preparing draft data, adding a file name and saving the draft data, *see* Takano, c. 6. ll. 44-59). Takano nowhere teaches or suggests that the functionality of its dedicated client software might be provided by a web browser.

In contrast, also as noted above, Serbinis specifically teaches away from the use of dedicated client software, in favor of using a generic web browser. In fact, avoiding the use of dedicated client applications is the primary object of Serbinis's invention: "[I]t is an object of this invention to provide a document management system and methods that permit electronic documents to be made available for use on open systems, such as the Internet, and to be accessed using previously known web browser-- without the need for a specialized client application." Serbinis, c. 2, ll. 46-51. Serbinis later notes that a benefit of Serbinis's system is that it "enables DMS system 17 to interact with users through a web browser, rather than requiring specialized client software." *Id.*, c. 5, ll. 4-6. Hence, while Takano requires the use of a specialized client application, Serbinis is specifically directed to a system that avoids the use of such specialized software. Serbinis, therefore, teaches away from the combination asserted by the Final Office Action.

Hence, the Final Office Action fails to establish any motivation or suggestion to combine the references in the manner contemplated by the Final Office Action, and any such suggestion is negated by the teachings of the references themselves. The proposed combination therefore fails to create a prima facie case of unpatentability under § 103(a), and the rejections of all claims should be reversed for at least this additional reason.

C. *There is no reasonable expectation of success in the combination of Takano and Serbinis.*

Even if the Final Office Action had made a showing of some suggestion or motivation to combine Takano and Serbinis (which, as noted above, it has not), the Final Office Action still would fail to establish a prima facie case that the claims at issue are unpatentable under § 103(a), because there would be no reasonable expectation of success in the asserted combination.

Merely by way of example, as noted above, while Takano requires specialized client software for the functioning of its system, Serbinis is directed to a system that uses a web browser instead of such specialized software. Nothing in the references or the Final Office Action explains how these two disparate systems might be combined with any expectation of success. For example, Serbinis teaches that a web browser uses the standard HTTP protocol to communicate with the server, and that the document management services (DMS) of Serbinis runs on a web server through the use of CGI programs. Serbinis c. 4, l. 61 – c. 5, l. 15. The browser, therefore, interacts with the DMS though the use of servlets. *Id.*

If a user were to use the client software of Takano to interact with DMS of Serbinis, that client software would have to be configured to use HTTP and servlets to perform such communication. However, as the system of Takano uses specialized software on the client and server, nothing in Takano teaches or suggests that the client software of Takano might be configured to interoperate generally with a web server using HTTP and servlets. Hence, if a user attempted to connect to the DMS of Serbinis with the client software of Takano, there would be no reasonable expectation that such a connection would be successful.

Accordingly, there would be no reasonable expectation of success in the combination of Takano with Serbinis. For at least this additional reason, the Final Office Action fails to establish a prima facie case that any pending claim is unpatentable under § 103(a) over the asserted combination of Takano and Serbinis, and the rejections of claims 4-9, 11-13 and 19-34 should be reversed for at least this additional reason.

8. Conclusion

The appellants believe that the above discussion is fully responsive to all grounds of rejection set forth in the application. The Final Office Action rejected the claims at issue under § 103(a) as being unpatentable over the combination of Takano and Serbinis. The asserted combination, however, fails to meet any of the three criteria required by MPEP § 2143 to establish a prima facie case of unpatentability under § 103(a). Accordingly, the rejections of all claims at issue should be reversed.

Please deduct the requisite fee of $500.00 pursuant to 37 C.F.R. §41.20(b)(2) from Deposit Account 20-1430 and any additional fees that may be due in association with the filing of this Brief.

Applicant believes no fee is necessary in association with the filing of this Amended Appeal Brief. However, the Commissioner is authorized to deduct from Deposit Account 20-1430 any additional fees that may be due in associated with the filing of this Amendment Appeal Brief.

Respectfully submitted,

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60714625 v1

9. APPENDIX

The claims pending in the application are as follows:

4.   (Previously Presented) The method of claim 19 wherein the first and second plurality of users exchange documents with the server via the public Internet.

5.   (Previously Presented) The method of claim 19 wherein the patent application is filed in the patent office with a correspondence mailing address set to an address associated with the server instead of an address associated with the second plurality of users.

6.   (Previously Presented) The method of claim 5 further comprising, receiving from the patent office, paper correspondence related to the patent application that is mailed to the server system address, scanning the paper correspondence to create a scanned, electronic copy of the correspondence and storing the scanned, electronic copy of the correspondence in the document collection comprising the patent application.

7.   (Previously Presented) The method of claim 6 wherein the scanned, electronic copy of the correspondence is viewable over the Internet by at least some of the second plurality of users.

8.   (Previously Presented) The method of claim 19 wherein the plurality of invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a Web page.

9.   (Previously Presented) The method of claim 19 wherein documents and data associated with each invention disclosure are stored in the database and viewable over the Internet to at least some users in the first and second plurality of users as determined by an access management portion of the server.

11. (Previously Presented) The method of claim 19 wherein the patent application is filed in the patent office electronically in response to the request.

12. (Previously Presented) The method of claim 19 wherein the patent application is printed on a printer coupled to the server system and subsequently filed in the patent office by mail in response to the request.

13. (Previously Presented) The method of claim 19 wherein the electronic documents include scanned versions of papers sent from a patent office.

19. (Previously Presented) A method of managing electronic documents related to a plurality of patent applications, the method comprising:

for a plurality of different and unrelated technology developers, allowing users from each such technology developer to create a plurality of invention disclosures for each respective technology developer;

receiving the plurality of invention disclosures from the users from each technology developer at a server system over a network and storing each invention disclosure in one of a plurality of collections of electronic documents and data in a computer-readable memory operatively coupled to the server system, wherein each collection is associated with one of the plurality of patent applications and assigned to at least one group that can be used in determining whether a user may access electronic documents and data in the particular collection;

storing, in the database, additional electronic documents associated with at least some of the plurality of invention disclosures for each technology developer;

maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents such that at least some users associated with each technology developer in the plurality of technology developers can access selected ones of the electronic documents associated with invention disclosures created for the respective technology developer and such that users associated with a particular technology developer cannot access electronic documents in the database associated with

invention disclosures of other unrelated technology developers in the plurality of technology developers;

        maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents for users associated with a plurality of patent firms such that at least some users from selected ones of the patent firms have rights to view selected invention disclosures stored in the collections and selected electronic documents stored in the collection selected invention disclosure is stored in and create and modify patent applications prepared for the selected invention disclosures;

        receiving any such created patent application at the server system and storing it in the collection of electronic documents the respective invention disclosure is stored in;

        maintaining and enforcing rights to file patent applications in a patent office for users associated with the plurality of law firms such that only selected users from the law firms have rights to file patent applications in the patent office; and

        electronically receiving a request from a user to file a particular patent application for a first technology developer in the plurality of technology developers, determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request;

        wherein each user from the plurality of different and unrelated technology developers and each user from the plurality of patent law firms is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in a particular collection of electronic documents and wherein each user is assigned one or more roles that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection; and

        wherein when a user generates a request to perform an operation on an electronic document in a particular collection of electronic documents, in response to receiving the request, determining (i) a first group to which the user is assigned; (ii) a

second group to which the electronic document assigned; (iii) one or more roles to which the user is assigned. (iv) unit level access information for the particular collection of electronic documents and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned, the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents.

     20.   (Previously Presented) A server system for managing intellectual property; the system comprising:

    a processor;

    a computer-readable memory, coupled to the processor, for storing a plurality of collections of electronic documents and data related to a plurality of invention disclosures for a plurality of different and unrelated technology developers, wherein the plurality of electronic documents include invention disclosures, patent applications and additional documents associated with the invention disclosures and/or patent applications;

    an invention disclosure creation component that allows users from each of the plurality of technology developers to create invention disclosures for the respective technology developer each client system is associated with and store the invention disclosures in the database as electronic documents;

    a patent application creation component that allows users associated with a plurality of patent firms to create and modify patent applications prepared for selected invention disclosures stored in the database and store the patent applications in the database as electronic documents;

    a document management and access component that maintains and enforces rights to electronic documents in the database such that, in response to receiving a request from a user to perform an operation on an electronic document in a particular collection of electronic documents, determining (i) a first group to which the user is assigned; (ii) a second group to which the electronic document assigned; (iii) one or more

roles to which the user is assigned. (iv) unit level access information for the particular collection of electronic documents and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned, the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents; and

a patent application filing component that, in response to receiving a request from a user to perform an operation of filing a particular patent application, causes the patent application to be filed in the patent office if the document management and access component determines the user has sufficient rights to perform the filing operation.

21. (Previously Presented) The method of claim 19 wherein the electronic documents in the plurality of collections comprise word-processed document files, form-based document files and image files.

22. (Previously Presented) The method of claim 21 wherein each electronic document in the plurality of collections of electronic documents has document meta data associated with the document that identifies the document.

23. (Previously Presented) The method of claim 22 wherein the document meta data further identifies the history of each document.

24. (Previously Presented) The method of claim 19 wherein the user cannot perform the operation on the electronic document if the user is excluded by the unit level access information.

25. (Previously Presented) The method of claim 19 wherein the user can perform the operation on the electronic document if the user is assigned a first permission from the set of permissions related to the operation and if the unit level access information permits the user to perform the operation.

26.   (Previously Presented) The method of claim 19 wherein the
plurality of groups is organized as a hierarchy such that a group in the plurality of groups
may contain one or more other groups in the plurality of groups.

27.   (Previously Presented) A method of managing electronic
documents related to a plurality of patent applications, the method comprising:

storing a plurality of collections of electronic documents and data on a
computer-readable memory operatively coupled to a server system, each collection being
associated with one of the plurality of patent applications and each collection including
data and one or more electronic documents related to its respective patent application,
wherein each collection is assigned to at least one group that can be used in determining
whether a user may access electronic documents and data in the particular collection, and
wherein the plurality of collections of electronic documents includes at least a first
collection associated with a first patent application;

allowing a plurality of users to perform operations on electronic
documents in the plurality of collections of electronic documents and data, wherein each
user is assigned to at least one group that can be used in determining whether a user may
access electronic documents and data in a particular collection of electronic documents
and wherein each user is assigned one or more roles that are associated with a set of
permissions that can be used in determining if a user can perform a particular operation
on a particular electronic document in a collection;

receiving a request from a first user to perform an operation on an
electronic document in the first collection; and

responsive to receiving the request, determining a first group to which the
first user is assigned; determining a second group to which the first collection is assigned;
determining one or more roles to which the first user is assigned and determining if the
user can perform the operation on the electronic document in the first collection based
upon the first group to which the user is assigned, the second group to which the first
collection is assigned and the set of permissions associated with the one or more roles to
which the user is assigned.

28. (Previously Presented) The method of claim 27 wherein the first collection associated with the first patent application includes unit level access information and wherein the step of determining if the user can perform the operation on the electronic document in the first collection is further based upon the unit level access information.

29. (Previously Presented) The method of claim 27 wherein the plurality of groups is organized as a hierarchy such that a group in the plurality of groups may contain one or more other groups in the plurality of groups.

30. (Previously Presented) The method of claim 27 wherein the electronic documents in the plurality of collections comprise word-processed document files, form-based document files and image files.

31. (Previously Presented) The method of claim 30 wherein each electronic document in the plurality of collections of electronic documents has document meta data associated with the document that identifies the document.

32. (Previously Presented) The method of claim 31 wherein the document meta data further identifies the history of each document.

33. (Previously Presented) The method of claim 27 wherein the user cannot perform the operation on the electronic document if the user is excluded by the unit level access information.

34. (Previously Presented) The method of claim 27 wherein the user can perform the operation on the electronic document if the user is assigned a first permission from the set of permissions related to the operation and if the unit level access information permits the user to perform the operation.

10. RELATED PROCEEDINGS APPENDIX

None

11. EVIDENCE APPENDIX

None

60714625 v1